

REMARKS

Prior to this amendment, claims 59-62 and 65-146 were pending. The present amendment cancels claims 61, 62, 67, 68, 75-78, 80-124, 126, 130-132, 134, and 138-146 without prejudice or disclaimer, amends claims 59, 65, 66, 125 and 133 and introduces new claims 147-155. The cancellation and amendment of the claims were not made in view of the current rejections. The amendments do not introduce new matter. Support for amended and new claims can be found in the specification at, *inter alia*, SEQ ID NO:1, pages 47 to 60 and page 89.

Claims 59-62 and 65-74, 79-88 and 93-146 are currently rejected under 35 U.S.C. § 102(e) as being anticipated by Ni et al., U.S. Published Application No. 20040136951 (hereinafter referred to as “Ni et al”). The examiner notes that Ni et al’s effective priority date is March 17, 1997, the filing date of provisional application 60/040,846 (“the 846 application”). Applicant respectfully traverses the rejection for at least the following reasons.


The Board of Patent Appeals and Interferences (“the Board”) has declared an interference, No. 105,361, between U.S. Patent No. 6,872,568 (the ‘568 patent) and application 10/423,448 (‘448 application). The ‘568 patent claims priority to the same applications as does the Ni et al reference that were filed prior to the filing date of the instant application. In particular, the ‘568 patent claims priority to U.S.S.N. 60/040,846 (“the ‘846 application”), filed on March 17, 1997, U.S.S.N. 60/054,021 (“the ‘021 application”), filed July 29, 1997 and U.S.S.N. 09/042,583 (“the ‘583 application”), filed March 17, 1998. The counts in Interference No. 105,361 pertain to, *inter alia*, an isolated monoclonal antibody or fragment thereof that specifically binds to a protein consisting of amino acid residues 1 to 133 of SEQ ID NO:2 wherein said antibody or fragment thereof is an agonist of the protein of SEQ ID NO:2 (“the Count”). SEQ ID NO:2 of that Count refers to an amino acid sequence for DR5/Apo-2 receptor. It is important to note that in declaring the Interference No. 105,361, the Board determined that

the '568 patent was not entitled to the benefit of any of the applications to which it claimed priority, including the '846, '021 and '583 applications, for the Count. *See, e.g.*, Declaration of Interference attached hereto at page 2 (i.e., "Accorded Benefit: None"). Applicant, therefore, submits that if the '846, '021 and '583 priority applications of Ni et al do not support the Count, those applications cannot support the currently claimed subject matter (e.g., methods of using DR5/Apo-2 antibodies). Accordingly, the Ni et al reference is not entitled to an effective filing date prior to the filing date of the instant application for the currently pending claims and, therefore, cannot be prior art to the current application under § 102(e). The Applicant therefore requests that the rejection be withdrawn and that the claims be passed to issue.

No new fees are believed to be due with the filing of this document. In the unlikely event that the Patent Office determines that extensions and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or fees due to our Deposit Account No. 18-1260, referencing Docket No. 22338-904. Any refund should be credited to the same account. The Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By: 
Jeffrey P. Kushan
Registration No. 43,401
Attorney for the Applicant

SIDLEY AUSTIN LLP
1501 K Street, N.W.
Washington, DC 20005
202-736-8914 (direct)
jkushan@sidley.com